

**REMARKS**

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

**I. CLAIM STATUS AND AMENDMENTS**

Claims 1-41 were pending in this application when last examined. In view of the election, claims 1-6, 11, 12, 15, 16, and 34-40 have been examined on the merits and stand rejected. Claim 17 is objected to.

Claims 7-10, 13, 14, and 18-33 are withdrawn from consideration as being drawn to non-elected subject matter.

The present amendment amends claims 2, 4-14, 17, 19-32, and 35-40.

The present amendment cancels claims 1, 15, 16, 18, 34, and 41 without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any canceled subject matter.

The present amendment adds new claim 42.

Claims 2-14, 17, 19-33, 35-40, and 42 are now pending in this application.

Support for the amendments to the claims can be found in the claims as originally filed.

Support for the “lauric diethanolamide or a compound including the same” in claims 2, 22, 23, and 26 can be found in original claims 2 and 7 and in the Specification, for example, at page 63, lines 8-10.

Support for “melatonin receptor agonist activity” and “one or more members selected from fatty acid esters and polyhydric alcohols” in claim 17 can be found in original claim 1.

Support for “melatonin related diseases” in claims 39 and 40 can be found in original claims 39 and 40, and in the Specification, for example, at page 3, lines 21-24, at page 11, lines 8-9, and at page 79, line 6 to page 80, line 9.

Support for the method terminology of claim 40 can be found in original claim 40 and in the Specification, for example, at page 92, lines 5-11.

Support for new claim 42 can be found in the Specification, for example, at page 78, lines 3-5.

Support for the changes in dependency of claims 2, 4-14, 19-22, 27, 30, 35-37, 39, and 40 can be found in the claims as originally filed.

Support for the changes to claim 38 can be found in the claim as originally filed.

Therefore, no new matter has been added by this amendment.

## **II. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

Claim 39 stands rejected under 35 U.S.C. § 112, first paragraph, on the basis that the Specification is enabling for treating melatonin-related diseases, but not for preventing melatonin-related diseases. See Office Action, pages 2-3.

As acknowledged at page 2, lines 10-11 of the Action, the Specification is enabling for treating melatonin related diseases. The claims have been amended to recite that which the Examiner has indicated is enabled. Thus, the rejection is deemed overcome by the current amendment.

## **III. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 39 and 40 stand rejected under 35 U.S.C. § 112, second paragraph as purportedly being indefinite for lacking essential method steps, particularly, the step of administering the preparation. See Office Action, page 3.

The present amendment amends the claims to include the requisite method steps of administering to a patient. The patients are exemplified on page 79, line 6 to page 80, line 9. Thus, the rejection is deemed overcome by the current amendment.

## **IV. OBJECTION UNDER 37 C.F.R. § 1.75(c)**

Claim 34 is objected to under 37 C.F.R. § 1.75(c) on the basis that it fails to further limit the subject matter of the previous claim. See Office Action, page 3.

The present amendment cancels this claim, thereby obviating this objection.

## **V. REJECTIONS UNDER 35 U.S.C. § 102(e)**

Claims 1-6, 11, 12, 15, and 34-40 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated over Ohkawa, U.S. Patent No. 6,034,239. See Office Action, page 4.

Applicants respectfully traverse this rejection as applied to the amended claims. The claims have been amended to depend on independent claim 17 which was indicated as allowable if written in independent form. Thus, the present amendment is deemed to overcome this rejection.

**VI. REJECTION UNDER 35 U.S.C. § 103(a)**

Claim 16 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ohkawa in view of Gilula et al., U.S. Patent No. 6,271,015. See Office Action, page 5.

Claim 16 has been canceled, thereby obviating this rejection.

**VII. OBJECTION**

Claim 17 is objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form. See Office Action, page 5.

Applicants thank the Examiner for acknowledging that claim 17 would be allowable if rewritten in independent form. The claim has been amended as such, thereby obviating this objection. Moreover, the remaining claims have been amended to depend on claim 17.

**CONCLUSION**

In view of the foregoing amendments and remarks, the present application is now in condition for allowance and early notice to that effect is hereby requested.


May 26, 2004

If it is determined that the application is not in condition for allowance, the Examiner is invited to telephone the undersigned attorney at the number below to expedite prosecution of the present application.

Respectfully submitted,

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